

Remarks

1. The applicants offer no substantive amendments to the claims as currently pending in this application since, in the applicants' view, the claims define an invention that is both novel and non-obvious over the prior art of record for the reasons as previously presented during the course of the prosecution of this application and, in particular, as presented in the Appeal Brief submitted on August 23, 2004.

2. The applicants maintain as entirely pertinent the whole of the submissions previously presented during the prosecution of this application. The following remarks are therefore presented in anticipation that it will be necessary to file yet another appeal in order to ensure that the previous submissions are properly considered. It is evident from a review of the prosecution history of this application that the Examiner has improperly made use of hindsight to establish his 35 U.S.C. §103(a) rejections of the main independent claims as pending in this application and, in the latest Office Action now being responded to, has taken a short-cut approach to re-presenting effectively the same 35 U.S.C. §103(a) rejections as addressed in applicants' Appeal Brief. In doing so, the Examiner has neatly sidestepped properly addressing the applicants' submissions in the Appeal Brief and in a manner that questions the integrity of the application/appeal process.

3. The applicants take this opportunity to recall that in *ex parte* examination of patent applications, the Patent and Trademark Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent and Trademark Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Plasecki*, 745 F.2d 1468,

1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent and Trademark Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on an applicant's disclosure. MPEP § 2142.

4. With the burden incumbent on the Office as established in law in mind, the applicants present the following comments. In the Office Action mailed March 29, 2005, the Examiner's main ground of rejection differs from that of the Final Office Action mailed March 31, 2004 (which was in essence the subject of the recent appeal) only insofar that the Examiner has inserted a reference to a new prior art reference, Vogel (US6075788), and the fact that this reference discloses a Sonet physical layer device having ATM and PPP interfaces which comprises PPP processing block. With this exception, the main ground of rejection in the Office Action mailed March 29, 2005 is identical word for word to that of the Final Office

Action mailed March 31, 2004. As such, the Examiner has repeated exactly the same assertions as to what each of Lyons (US8075798) and Nagami (US5822319) is alleged to disclose and has not addressed any of the applicants' submissions as previously presented in the application process to date and, in particular the Appeal Brief, which clearly demonstrate that the Examiner's assertions as to what these two references disclose is incorrect. Not one of the applicants' submissions in the Appeal Brief is addressed. Such a short cut approach to re-presenting effectively the same rejection is improper.

5. The Office has to accept that, since the Examiner has augmented his main ground of rejection to include Vogel, the previous main ground of rejection relying on the combination of Lyons and Nagami was flawed. Therefore, one would anticipate that the Examiner would be at pains in the latest Office Action to explain how it is that such a flawed ground of rejection can be made good by the inclusion of Vogel. Therefore, what is most disconcerting for the applicants is that, in making the new ground of rejection under 35 U.S.C. §103(a) through the combination of Lyons, Nagami and Vogel, the Examiner makes no effort to explain where one would find the suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the three reference teachings or which of the claim limitations are provided by the new reference, Vogel, all of this occurring in the light of the detailed submissions in the applicant's Appeal Brief as to the true, i.e. lack of, relevance of the Lyons and Nagami references to the present invention. What the Examiner has achieved in this process is the equivalent of breathing life into a long dead corpse through the application of a single Band Aid to one of a hundred fatal slashes.

6. For the sake of brevity, applicants will not repeat the many, detailed submissions of the Appeal Brief but directs attention to section 8, "Argument" of the Brief. Despite the fact that the Appeal Brief does not address the relevance of Vogel, it is submitted that the failings of Lyons and Nagami are such that there is

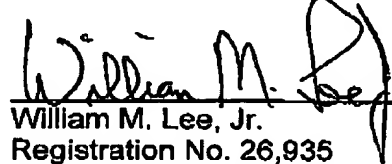
nothing in the teaching of this further reference that could possibly lead one skilled in the art to modify the system of Lyons with the methods disclosed by Nagami and Vogel in order to arrive at the arrangement of the present invention.

7. The Examiner has suggested that applicant's arguments with respect to claims 12 to 99 are moot in view of the new ground of rejection. They clearly are not moot since the Examiner has failed to satisfy the burden established in law for denying patentability under 35 U.S.C. §103(a) and requests that the Office now allow this application.

8. Favorable reconsideration is therefore urged.

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Respectfully submitted,


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